

REMARKS

In the Final Office Action dated March 2, 2006, the Examiner rejected claims 1-3, 7, 10, 15-23, 25, 26, 29-31 and 34-40 under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 3,085,628 to Malone ("Malone"). The Examiner rejected claims 4-6, 8, 9, 11-14, 24, 27, 28, 32, 33, 41 and 42 under 35 U.S.C. 103(a) as being unpatentable over Malone in view of U.S. Patent 6,575,251 to Watson et al. ("Watson"). The Examiner has sustained her rejection of claim 43 under 35 U.S.C. § 103(a) as being unpatentable over Malone in view of United States Patent No. 4,627,488 to Szarka (hereinafter "Szarka"). The Examiner has sustained her rejection of claims 1-42 and 44-52 under 35 U.S.C. § 103(a) as being unpatentable over Watson in view of Malone or United States Publication No. 2004/0020644 in the name of Wilson et al. (hereinafter "Wilson"). Finally, the Examiner sustained her rejection of claim 43 under 35 U.S.C. §103(a) as being unpatentable over Watson in view of Szarka and further in view of Malone or Wilson.

Rejections under 35 U.S.C. 102

With respect to the rejection of claims 1-3, 7, 10, 15-23, 25, 26, 29-31 and 34-40 under 35 U.S.C. 102(b) as being anticipated by Malone, the Examiner has conceded that Malone does not disclose filling the inflatable element with filtered gravel slurry. The

Examiner asserts, however, that the language "adapted for inflation" is not entitled to be given any patentable weight.

Without conceding this point, and while retaining all rights without prejudice, Applicant has amended the pending independent apparatus claims in order to more clearly define certain patentable subject matter disclosed within the originally-filed application. Applicant respectfully submits that the amendments do not add any new matter and their entry is respectfully requested.

As amended, the pending claims explicitly require that the inflatable element is filled with an inflating fluid obtained by filtering gravel-laden slurry. Accordingly, the Examiner's position that the earlier "adapted to" language used in the claims is not entitled to patentable weight does not apply to the claims as amended. Accordingly, Applicant respectfully submits that the Examiner's rejections under 35 U.S.C. 102 have been overcome by these amendments and Applicant respectfully requests withdrawal of these rejections.

Rejections under 35 USC 103

Claims 1-42 and 44-52 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Watson in view of Malone or Wilson. Applicant respectfully submits that Watson, Malone and Wilson do not, even in combination, support a prima facie case of obviousness under 35 U.S.C. 103.

Watson fails to teach "filtering a gravel laden slurry"

Watson is directed to an inflatable element that is adapted for inflation by gravel laden slurry. Specifically, Watson discloses a method of sealing an annulus in a well comprising expansion of the inflatable element with a gravel laden slurry. The inflatable element comprises a passageway communicating between an exterior and an interior of the inflatable element. The inflatable element is capable of being connected to a sand screen and the inflatable element can be inflated with the gravel laden slurry during a gravel packing of the well. With respect to claims 44 and 49, the Examiner asserts that Watson discloses:

Providing a sand screen completion including the inflatable element.

Gravel packing at least a portion of the well with a gravel slurry.

Using the gravel slurry to inflate the element.

Watson does not, however, disclose filling the inflatable element with an inflating fluid obtained by filtering the particulates from a gravel laden slurry. To the contrary, Watson *specifically* teaches that the fluid filling the inflatable element is the *unfiltered* gravel laden slurry.

The Examiner concedes that Watson fails to disclose a particulate filter located in the passageway for filtering fluid from the gravel slurry. In order to overcome the limitations of Watson, the Examiner cites Malone and Wilson for a teaching of filtering the inflation fluid. The Examiner asserts that it would

have been considered obvious to one of ordinary skill in the art, at the time the invention was made, to have modified the system of Watson to include a filter means as taught by Malone and Wilson in order to have prevented damage to the inflatable element and to have prevented a build up of debris in the inflatable element thus hampering the deflation of the element.

Malone fails to teach "filtering a gravel laden slurry"

Malone depicts an inflatable tool disposed in a wellbore supported on tubing. The inflatable tool is inflated with fluid passed through a filter or screen in order to prevent contamination. The filter or screen is intended to inhibit the settling of foreign matter on the surface of the resilient member of the check valve, which would tend to inhibit sealing. Malone does not, however, discuss the use of a filter to separate gravel from a slurry, or the use of filtered slurry to fill the inflatable member.

Wilson fails to teach "filtering a gravel laden slurry"

Like Malone, Wilson teaches inflating a packer with fluids, and teaches filtering such fluids in order to remove undesirable particulate matter. Wilson does not, however, teach the use of gravel laden slurry in any respect, and specifically fails to teach filtering of a gravel laden slurry or the inflation of a packer with fluid produced by filtering of gravel laden slurry.

No cited reference teaches "filtering a gravel laden slurry"

As can be seen by reference to the above discussion, the principal problem with the Examiner's argument is that *not a single* one of the references teaches filtering gravel laden slurry for any purpose. That is, the step of "filtering a gravel laden slurry" is completely absent from the combination of references. Accordingly, the references do not, alone or in combination, teach each and every element of the claimed invention, as required for a prima facie showing of obviousness under 35 U.S.C. 103. Accordingly, Applicant respectfully submits that the claims are allowable over the cited art.

Fee Statement

The total number of claims is unchanged and the number of independent claims is unchanged by way of the present Response. Applicant is submitting this amendment in conjunction with a request for continued examination and the appropriate fee. Applicant submits that no fees not enclosed herewith are due in connection with this response. If any fees are due, please charge our Deposit Account No. 03-1130.

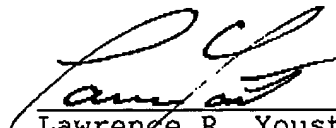
Conclusion

Applicant respectfully submits that none of the art cited by the Examiner either alone or in combination teaches, suggests or discloses an inflatable element filled with an inflating fluid

obtained by filtering the particulates from a gravel laden slurry using a particulate filter. In view of the foregoing, the Examiner is respectfully requested to allow claims 1-49 and 53-55 presented for consideration herein. Accordingly, a favorable action in the form of an early notice of allowance is respectfully requested. The Examiner is requested to call the undersigned for any reason that would advance the instant application to issue.

Dated this 31st day of May, 2006.

Respectfully submitted:



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